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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,299	12/05/2000	Kenneth H. Falchuk	healre01.012	7848
25247	7590	10/18/2005	EXAMINER	
GORDON E NELSON PATENT ATTORNEY, PC 57 CENTRAL ST PO BOX 782 ROWLEY, MA 01969			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/730,299

Applicant(s)

FALCHUK ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

EA

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 08 April 2005. Claim 2 has been amended. Claims 1-4 remain pending.

Specification

2. The objection to the abstract of the disclosure because it exceeds 150 words in length still stands, as the abstract has not been amended. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

(A) Independent claim 1 recites a “receiving a comment” step and a “providing the comment” step but fails to include the active step of providing continuing medical education credit, as required by the preamble.

(B) Claims 2-4 incorporate the features of independent claim 1, through dependency and are also rejected.

Claim Rejections - 35 USC §101

5. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when “the practical application of the abstract idea produces a useful, concrete, and tangible result” (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)).

As per Applicant’s recited invention, in general a method for providing continuing medical education credit is conceptually useful for providing accreditation to a physician.

However, for a claimed invention to be statutory it must also produce a tangible result, and it is respectfully submitted that in the present case, claims 1-4 do not have a tangible result, as there is no tangibly embodied continuing medical education credit that results from the method steps, and thus the invention fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

Furthermore, for a claimed invention to be statutory it must also produce a concrete result, that is, a result must be assured or repeatable. Upon further analysis of claims 1-4 Examiner has reassessed their concreteness and notes that the results of the recited receiving and providing steps are not assured, that is, a subjective evaluation done by the medical information

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specialist might result in different final results depending on different comments received. Thus the invention fails to meet the test for concreteness.

In light of the above, it is respectfully submitted that the claimed invention, although useful, is not tangible and concrete, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by Minnesota Medical Association Report on Telemedicine article, September 1996, URL: <http://www.mnmed.org/Protected/telemedicine.pdf>, hereinafter known as Telemedicine for substantially the same reasons given in the previous Office Action (paper number 12182004). Further reasons appear hereinbelow.

(A) Claim 1 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 12182004, section 6, page 5), and incorporated herein.

(B) As per the amendments to claim 2, such as those that substitute the word “data base” for “information,” and “specialist” for “expert” these appear to have been made merely to correct minor typographical or grammatical errors. While these changes render the language of

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the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 12182004, section 6, page 6), and incorporated herein.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minnesota Medical Association Report on Telemedicine article, September 1996, URL: <<http://www.mnmed.org/Protected/telemedicine.pdf>>, hereinafter known as Telemedicine, as applied to claims 1 and 2 above and further in view of Abrahamson et al, U.S. Patent Number 5, 002, 491 for substantially the same reasons given in the previous Office Action (paper number 12182004). Further reasons appear hereinbelow.

(A) Claims 3-4 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 12182004, section 8, pages 7-8), and incorporated herein.

Response to Arguments

10. Examiner notes that this reply is in response to pages 13-21 of Applicant's amendment filed 08 April 2005.

(A) On pages 17-18 of Applicant's response filed 08 April 2005 Applicant argues the rejection of claims 1-4 under 35 U.S.C. § 101. Examiner has considered Applicant's arguments and has reconsidered this rejection, and has rewritten the rejection accordingly.

(B) With regard to Applicant's assertion that the rejection of claims 1 and 2 under 35 USC § 102 (e) should have been a rejection under 35 USC § 102 (a), Examiner agrees with Applicant's statement and thanks Applicant for this analysis.

(C) Applicant's arguments on pages 19-21 of the response filed 08 April 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 08 April 2005.

At pages 19-21 of the 08 April 2005 response Applicant argues that the features claimed in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including limitations recited in the preamble, and including the newly added limitations of the amendment filed 08 April 2005, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Telemedicine and Abrahamson, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office

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Action and in the prior Office Action (paper number 12182004), and incorporated herein. In particular, Examiner notes that the features of "providing medical education credit," as recited in the preamble of claim 1 are taught by the applied references (Telemedicine; see at least page 4, column 2, paragraphs 2-6).

With regard to Applicant's argument at page 20, paragraph 3 of the 08 April 2005 response that the Telemedicine reference fails to teach the limitations recited in claim 1, Examiner respectfully disagrees. Examiner interprets Telemedicine's teachings of "[o]ther telemedical physician education systems include: the Medical News Network, the Physicians Television Network, and the Pyramed Network, all of which offer continuing medical education credits to physicians (AMA CMS/CME Report A-94)" (Telemedicine; page 4, column 2, paragraph 4) as teaching "providing continuing medical education credit;" and Telemedicine's teachings of "a software system that enables family physicians and specialists to exchange stored video images and medical records [reads on "comments"]" (Telemedicine; page 22, column 1, paragraph 4) as teaching "receiving a comment made with regard to the consultation via the telecommunications system from the second physician" and Telemedicine's teachings of "[t]he Minnesota Health Data Institute (MHDI) health care telecommunications network, MEDNET, officially went on-line in August 1995. ... The purpose of MEDNET is to exchange administrative, clinical, and analytical health care information in an efficient, reliable manner support the exchange of administrative information ... eligibility data collection and maintenance of specialized ... databases that can be used for performance measurement and improvement studies as well as access to external and public and private databases ..." (Telemedicine; page 22, column 1, paragraph 4 to column 2, paragraph 1) as teaching "providing

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the information [reads on "comment"] to a medical information specialist in the intermediary who is neither the first nor the second physician," and Telemedicine's teachings of "specialized clinical databases that can be used for performance measurement ...the ability to electronically ... submit authorizations ... the ability to verify eligibility" (Telemedicine; page 22, column 2, paragraphs 1-2) as teaching "the information specialist indicating continuing medical education credit for the first physician based at least on the information [reads on "comment"] in a database accessible from the intermediary." Furthermore, the courts have stated that if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). (See MPEP 2112.02).

With regard to Applicant's argument at the paragraph bridging pages 20-21 of the 08 April 2005 response that the Telemedicine reference fails to teach the limitations of dependent claim 2, Examiner respectfully disagrees, noting that the teachings of an intermediary in a consultation between doctors has already been discussed in this Office Action.

With regard to Applicant's argument at page 21 of the 08 April 2005 response that the combined applied references fail to teach the limitations of dependent claims 3-4, Examiner respectfully disagrees, noting that the teachings of Abrahamson were applied to the limitations that recited providing an examination, receiving answers for the examination, and grading the

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received answers as recited by dependent claims 3-4 and as analyzed and described in the previous Office Action (paper number 12182004).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied reference Dirbas, U. S. Patent Number 6, 125, 350, Allison, U. S. Patent Number 6, 546, 230, and the articles teach the environment of providing online education and accreditation.

1995 Innovative Use of Technology Award Winners. NASCIO website. 1995. [Retrieved on October 12, 2005]. Retrieved from Internet. URL:
<<http://www.nascio.org/awards/1995awards/aw95it.cfm>>.

Orthopaedists investing in home study. AAOS Bulletin. Vol. 43, No. 3, July 1995.
[Retrieved on October 12, 2005]. Retrieved from Internet. URL:
<<http://www.aaos.org/wordhtml/bulletin/homestdy.htm>>.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

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For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the communication
and do NOT sign the communication.

After Final communications should be labeled "Box AF."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.


14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

October 12, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600